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Law Offices

CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.
 Patents, Trademarks & Copyrights
 12th Floor - Seven Penn Center
 1635 Market Street
 Philadelphia, PA 19103-2212
 (215) 567-2010
 Fax : (215) 751-1142

*Alan H. Bernstein
 Stanley H. Cohen
 Manny D. Pokotilow
 Barry A. Stein
 Martin L. Faigus
 Eric S. Marzluft
 Robert S. Silver
 Michael J. Berkowitz
 Scott M. Slomowitz*
 Mona Gupta*

*David M. Tener
 Salvatore R. Guerriero*
 James J. Kozuch
 William J. Castillo†
 Frank M. Linguit
 Gary A. Greene
 Michael J. Cornellison
 Bruce J. Chasan
 Marina E. Volin*

*A.D. Caesar
 (1901-1995)
 Charles W. Rivise
 (1900-1951)
 Counsel
 Allan H. Fried
 Of Counsel
 Max Goldman**

** Also admitted to practice in NJ
 † Admitted only in NJ and NY*

FACSIMILE TRANSMITTAL SHEET

January 29, 2004

TO: Examiner S. Chunduru
 Group Art Unit 1637
 U.S. Patent & Trademark Office
 FACSIMILE NO.: (703) 872-9306
 FROM: David M. Tener, Esq.
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Our Reference No.: E1047/20048

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FACSIMILE TRANSMISSION CERTIFICATION

I hereby certify that this correspondence (including the attached **Request for Reconsideration**) regarding the application identified below, is being transmitted via facsimile to the United States Patent and Trademark Office on this 29th day of January, 2004.

David M. Tener, Reg. No. 37,054

Applicant(s): Glen H. ERIKSON et al.

Serial No: 09/713,177

Group Art Unit: 1637

Filed: November 15, 2000

Examiner: S. Chunduru

Att. Docket No.: E1047/20048

Confirmation No.: 3217

For: TRIPLEX AND QUADRUPLEX CATALYTIC HYBRIDIZATION

OFFICIAL**PATENT****RECEIVED
CENTRAL FAX CENTER****JAN 29 2004****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION**

Applicant(s): Glen H. ERIKSON et al.

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REQUEST FOR RECONSIDERATION

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated October 29, 2003, favorable reconsideration is respectfully requested in view of the following remarks. Claims 1-63 are pending.

Claims 1-63 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,451,502 (hereinafter "George") in view of McGavin et al., J. Mol. Graphics, Vol. 7, pp. 218-232, 1989 (hereinafter "McGavin"). This rejection is respectfully traversed.

George teaches catalytic hybridization. McGavin is cited to remedy George's acknowledged failure to "specifically [teach] that the multiplex structure (probe-target complex) is [bonded] solely through Watson-Crick base triplets." See Office Action at page 5, last full paragraph. McGavin discloses theoretical, computer-based models for multiplex nucleic acid sequences based on Watson-Crick bonding, but does not disclose or suggest how the virtual structures described by the computer models could be prepared using real nucleic acids. Thus, McGavin is non-enabling prior art, which the Office Action applies based on an improper "obvious-to-try" standard of obviousness.

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In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 726, 16 USPQ2d 1923, 1929 (Fed. Cir. 1990), the court held:

[A]n "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). However, we have consistently held that "obvious to try" is not to be equated with obviousness under 35 U.S.C. §103.

One skilled in the art at the time of the invention would have lacked motivation to employ the purely theoretical teachings of McGavin to modify the primary reference, George, and reach the claimed invention with a reasonable expectation of success. McGavin's virtual teachings provide no guidance regarding how George could be modified to reach the reality of the claimed invention. McGavin simply "does not contain a sufficient teaching of how to obtain the desired result." *Gillette Co.*, *supra*, 919 F.2d at 726.

Accordingly, reconsideration and withdrawal of the obviousness rejection over George in view of McGavin are respectfully requested.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

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Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

January 29, 2004

Please charge or credit our Account
No. 03-0075 as necessary to effect
entry and/or ensure consideration of
this submission.

By 

David M. Tener
Registration No. 37,054
Customer No. 03000
(215) 567-2010
Attorneys for Applicants